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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,463	03/27/2001	William Skiles	SKILES 00.01	1833

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Dale F. Regelman
HAYES, SOLOWAY, HENNESSEY, GROSSMAN & HAGE, P.C.
130 W. Cushing Street
Tucson, AZ 85701

EXAMINER

RODRIGUEZ, RUTH C

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 04/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,463

Applicant(s)

SKILES, WILLIAM

Examiner

Ruth C Rodriguez

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-15 is/are rejected.
- 7) ☒ Claim(s) 8 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

Information Disclosure Statement

2. The information disclosure statement filed 05 July 2001 has been considered for this Office Action.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "724" has been used to designate both the distal end and the first surface. Also reference character "734" has been used to designate both the distal end and the first surface.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 722, 732, 822 and 832.
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: D4, 414 and 854.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities: Page 7, Line 17, "13" should be replaced with --130--. Correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "the inner surface" in the third line of the claim.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 5 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Willner (US 3,693,376).

A clasp (10) for releaseably holding an ornamental object (16) comprising a first fixture (14), a second fixture (14) and a member (12). The first fixture has a first surface (20) and a second surface where the first surface of the first fixture has a concave

shape (22) (Figs. 1-4). The second fixture has a first surface (20) and a second surface where the first surface of the second fixture has a concave shape (22) (Figs. 1-4). The member has a first end (18) and a second end (18) where the first end is disposed on the second surface of the first fixture and the second end is disposed on the second surface of the second fixture (Figs. 1-3).

The member disclosed by Willner has a semicircular shape (Fig. 1-3).

A method to releasably hold an ornamental object (16) comprising the steps of providing a clasp (10) and disposing the ornamental object within the clasp (Figs. 1-3). The clasp comprises a first fixture (14), a second fixture (14) and a member (12). The first fixture has a first surface (20) and a second surface where the first surface of the first fixture has a concave shape (22) (Figs. 1-4). The second fixture has a first surface (20) and a second surface where the first surface of the second fixture has a concave shape (22) (Figs. 1-4). The member has a first end (18) and a second end (18) where the first end is disposed on the second surface of the first fixture and the second end is disposed on the second surface of the second fixture (Figs. 1-3). The ornamental object is disposed between the first fixture and the second fixture such that the first fixture urges the ornamental object against the second fixture and the second fixture urges the ornamental object against the first fixture (C. 2, L. 31-51 and Figs. 1 and 3).

The member has a semi-circular shape (Figs. 1-3).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3677

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 3, 4 and 11-13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Willner.

Willner discloses a clasp having all the limitations listed above for the rejection of claim 5 above. Willner also discloses that the specific configuration of the first and second fixtures is not critical because the important aspect of the invention is to have the first surfaces with a concave surface that are connected to the ends of the member (C. 2, L. 18-30). Willner fails to disclose that the first and second surfaces comprise a convexoconcave structure. However, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have a convexoconcave structure having an inner concave surface, an outer convex surface and an edge continuously joining the inner concave surface and the outer surface for the first and second fixtures disclosed by Willner because a change in shape of the prior art is considered a design choice within the ordinary skill in the art. In this case, changing the configuration of the outer surface to have a convex shape does not change the way the invention works because as cited by Willner the important aspects of his invention are to have inner concave surfaces, that remains the same, to receive the ornamental object and have the member connected to the second surface, that also remains the same.

Willner also discloses the method of disposing an ornamental object within the clasp. Willner fails to disclose that the method further comprises the steps of providing

a first force urging the ornamental object in a first direction and a second force urging the ornamental object in a second direction and adjusting the magnitude of the forces by altering the thickness of the member or by altering the radius of the member.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made have a first force urging the ornamental object in a first direction and a second force urging the ornamental object in a second direction because providing first and second forces urging the ornamental object in a first or second direction is required in order to be able to retain the ornamental object between the first and second fixtures of the clasp.

Similarly, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to adjust the magnitude of the first force and the second force by altering the thickness of the member. One with ordinary skill in the art will recognize that increasing the thickness of the member increases the magnitude of the forces because an increase in the area of the member represents an increase in the forces urging the ornamental object toward an opposite direction. Likewise, it would have been obvious to one having ordinary skill in the art at the time the invention was made to adjust the magnitude of the first force and the second force by altering the radius of the circular member. Once again, one with ordinary skill in the art will recognize that decreasing the radius will increase the magnitude of the first force and second force because decreasing the radius will create a greater compression force between the ends of the member therefore increasing the forces.

13. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Willner in view of Buddle (US 6,101,655).

Willner discloses a clasp having all the features listed above for the rejection of claim 1. Willner fails to disclose that cellular material is disposed on the first surfaces of the first and second fixtures. However, Buddle teaches a device for preventing slippage of heel of woman's shoe. The device is comprised of a cellular foam insert positioned on the shoe. The cellular foam is chosen because this material prevents the slippage between the heel and the shoe. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have a first cellular material disposed on the first surface of the first fixture and have a second cellular material disposed on the first surface of the second fixture according to the teachings of Buddle in the clasp disclosed by Willner. Doing so, will provide a material that prevents slippage of the ornamental object with respect to the first surfaces of the first and second fixtures.

14. Claims 6, 7, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willner in view of Durham et al. (US 4,835,824).

Willner discloses all the features mentioned above for the rejection of claims 5 and 13. Willner fails to disclose that the clasp further comprises a first connector and a second connector included as part of the member. However, Durham discloses a medical clamp (14) comprised of a first fixture (28), a second fixture (29) and a member (10) connecting the first fixture by a first end (22) and to the second fixture by the second end (26). The member further comprises a first end portion (16), a second end

portion (18) and a midpoint (12). The first end portion connects the first end and the midpoint and the second portion connects the second end and the midpoint. The clamp further comprises a first connector (42) and a second connector (44). The first connector has a first proximal end and a first distal end (50). The first proximal end is disposed on the first end portion of the member such that the distal end extends outwardly from the member in the direction of the second end portion (Figs. 1-3 and 5). The second connector has a first proximal end and a first distal end (52). The first proximal end is disposed on the first end portion of the member such that the distal end extends outwardly from the member in the direction of the second end portion (Figs. 1-3 and 5). The first distal end is moveably connected to the second distal end (Figs. 3 and 5). The first and second connectors are used to selectively hold the first end portion and the second end portion at a desired spacing (C. 3, L. 2-20). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the first connector and the second connector according to the teachings of Durham in the clasp of Willner. Doing so, will allow to selectively holding the first end portion and the second end portion at a desired spacing.

Durham also teaches that the first distal end comprises a first ratchet portion (46) and the second distal end comprises a second ratchet portion (48) where the first distal portion is disposed adjacent to the second distal end such that the first ratchet portion slidably mating with the second ratchet portion (Figs. 3 and 5).

Regarding to the method, Durham fails to disclose that the method further comprises the step of moving the first end portion of the member toward the second end

portion of the member, moving the second end portion of the member toward the first end portion of the member and releaseably coupling the first distal end to the second distal end. However as discussed above, Durham teaches a clasp having all the structural limitation for the first connector of the first distal end and the second connector of the second distal end. Durham also teaches the steps of moving the first end portion of the member toward the second end portion of the member, moving the second end portion of the member toward the first end portion of the member and releaseably coupling the first distal end to the second distal end (C. 3, L. 31-47).

As mentioned above, Durham discloses the first ratchet portion and the second ratchet portion and the step of slidably mating the first ratchet portion with the second ratchet portion (C. 4, L. 26-33).

Allowable Subject Matter

15. Claims 8 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wecht (US 1,251,308), Kirshner (US 3,014,298), Johnson (US 4,195,492), Milawski (US 4,625,526), Santiago (US 5,433,090), Guio (US 5,440,791), Hanson (US 5,946,943) and German Patent Document DE 31 04 396 A1 are cited to show state of the art with respect to the use of clasps or clips having some of the features claimed under the current application. Miller (US 3,896,527) and Willoughby

(US 4,536,924) are cited to show state of the art with respect to the use of a ratchet system to urge two sides of a clamp together.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C Rodriguez whose telephone number is (703) 308-1881. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (703) 306-4115.

Submissions of your responses by facsimile transmission are encouraged. Technology center 3600's facsimile number for before final communications is (703) 872-9326. Technology center 3600's facsimile number for after final communications is (703) 872-9327. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase the patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as PTO's mailroom processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP § 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee that the applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

I hereby certify that this correspondence is being facsimile transmitted to
the Patent and Trademark Office (Fax No. (703) 872-9326) on (Date).

(Signature)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

rcr
April 17, 2002

J. J. Swann
J. J. SWANN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600